The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEAL G. SKINNER

Appeal No. 2005-2418
Application 09/932,639

ON BRIEF

Before THOMAS, LEVY, and SAADAT, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board since the examiner has twice rejected the pending claims 11 through 13, 19, 20, 25, 27, 28, 30, 39, 40 and 44 through 61 within 35 U.S.C. § 134. The examiner's last Office action rejecting the claims on appeal was a non-final Office action mailed on November 17, 2003. The claims on appeal are claims 19, 20, 25, 30, 39, 40, 44, 45, 47

through 49 and 52 through 58, since the examiner has allowed claims 11 through 13, 27 and 28 and has objected to claims 46, 50, 51 and 59 through 61. We consider on the merits the arguments presented in the Supplemental Brief filed on February 17, 2004.

Representative claim 25 is reproduced below:

25. An electrical power distribution system, comprising:

a fiber optic line;

multiple power consuming devices; and

multiple control modules interconnected between the fiber optic line and the power consuming devices, each of the control modules being interconnected between the fiber optic line and one of the power consuming devices, and each of the control modules being operative to select the respective power consuming device for supplying electrical power thereto in response to one of multiple optical wavelength bands transmitted through the fiber optic line, each of the optical wavelength bands causing one of the control modules to select the respective power consuming device for supplying electrical power thereto,

the multiple optical wavelength bands being transmitted singly through the fiber optic line.

The following references are relied on by the examiner:

Endo et al. (Endo)	4,495,421	Jan. 22, 1985
Pitt et al. (Pitt)	4,928,319	May 22, 1990
Davis	4,941,201	July 10, 1990
Tymes	5,193,201	Mar. 9, 1993

Claims 25 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Endo. This reference is used alone to reject claims 39, 40, 44, 45, 47 through 49, and 52 through 58 under 35 U.S.C. § 103. Claims 19 and 20 stand rejected under 35 U.S.C. § 103 as well. As to claim 19, the examiner relies upon Pitt in view of Davis, substituting Tymes for Davis in the rejection of independent claim 20.

Rather than repeat the positions of the appellant and the examiner, reference is made to the Brief (no Reply Brief has been filed) for appellant's positions, and to the Answer for the examiner's positions.

OPINION

We turn first to the rejections utilizing Endo. As to the examiner's anticipatory rejection of claims 25 and 30 based on this reference, we sustain the rejection of independent claim 25 but reverse the rejection of independent claim 30.

In affirming the rejection of independent claim 25, we agree with the examiner's statement of the rejection of this claim at pages 3 and 4 of the Answer in addition to the responsive arguments at pages 9 through 13. Correspondingly,

we do not agree with appellant's arguments at pages 7 through 9 of the Brief as to claim 25.

Even if we were to agree with appellant's views that the recitation at the end of claim 25 that the optical wavelength bands are transmitted through a fiber optic line singly to mean without the company of others or individually, we find ourselves in agreement with the examiner's observations at the top of page 11 of the Answer that the optical switches 20 figures 2 and 4 of Endo may be manually operated one at a time or two at a time or three at a time as illustrated among these figures. The disclosure of Endo's embodiments in figures 2 and 4 at columns 3 through 5 of this patent indicates the individual actuability of the manual switches 3 by the user and, contrary to the arguments presented at page 8 of the Brief, does not require the actuation of these switches simultaneously even though the capability exists for this to happen. The "multiple control modules" clause states that "one of multiple optical wavelength bands transmitted through the fiber optic line", yet this language does not require that these multiple optical wavelength bands be transmitted at the same time or individually. It is thus seen from a study of the embodiments in figures 2 and 4 of

Endo that the capability exists for multiple optical wavelength bands having different specific wavelengths to be transmitted, but done so singly or in an individual manner to the extent argued.

As to the argument that Endo does not teach collectively supplying power or transmitting data to multiple devices, we disagree with this argument in addition to agreeing with the examiner's remarks beginning at the bottom of page 11 of the Answer. According to the first embodiment of figure 2 of Endo, which is the basis for the structure of the second embodiment in figure 4, at least the photoelectric transducer 31 may comprise the claimed device to be powered by the specific wavelengths of light transmitted on the optical fiber 40. In fact, as the examiner has noted, the electrical power is supplied to the entire switching unit 30 in figures 2 and 4.

As to independent claim 30, also rejected under 35 U.S.C. § 102 as being anticipated by Endo, we must reverse this rejection. Initially, we observe that independent claim 30 appears to be modeled after independent claim 25 with two major distinctions. There is no dispute by appellant that optical wavelength bands in Endo may be transmitted simultaneously since that was the substance of the major argument presented for

reversal of claim 25. Indeed, Endo does have the capability to do that.

Secondly, the optical coupler set forth at the end of claim 30 on appeal is stated to receive separate optical wave-length bands from multiple lasers with at least one of these multiple lasers being a tunable laser. We agree with appellant's views expressed at pages 9 and 10 of the Brief that Endo does not teach tunable lasers. A generic type of light emitting element 22 is taught to be within the optical signal generator switch 20 in detail in figure 2 of Endo. Even if we accept that the artisan would have considered this type of device to have been a light emitting diode (bottom of Brief, page 16), and even if the artisan would have considered that such a generic light emitting element 22 may have been in the form of a solid state laser, we would be exercising speculation if we were to agree with the examiner's view that such could include a tunable laser. Because in the figure 4 embodiment separate optical signal generator switches 20 are utilized for each of the respective manual switches 3 to operate separate devices, the artisan would have had no need to have utilized a tunable laser for such light emitting elements, only a fixed frequency laser at most. Therefore, we reverse the rejection of independent claim 30.

Turning next to the rejections under 35 U.S.C. § 103 utilizing Endo alone, we reverse the rejection of independent claims 39 and 40 essentially for the reasons set forth by the appellant in the Brief. At the outset, additionally, we recognize that the examiner already admits that Endo does not teach that the electronic devices may be data storage devices of claim 39 or devices with programmed functions in claim 40 at page 7 of the Answer. The examiner's reasoning there that Endo may have or "can have" such devices is mere speculation. From our study of Endo, there is no teaching or inference the artisan may fairly derive from Endo that these devices are contemplated or otherwise taught or suggested in this reference.

On the other hand, we do sustain the rejection of independent claim 44 in accordance with the reasoning advanced by the examiner at pages 7 and 8 of the Answer along with the additional remarks in the responsive arguments portion of the Answer as to the rejection of claim 44 at pages 13 and 14.

A different intended use of the same structure as in the prior art does not prohibit a statutory anticipation rejection, for example. Indeed, it has been stated by our reviewing court that "the absence of a disclosure relating to

function does not defeat the Board's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable (case citations omitted)." In re Schrieber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The court concludes at 128 F.2d 1477, 44 USPQ2d 1431-32, that "Schrieber's contention that his structure will be used to dispense popcorn does not have patentable weight if the structure is already known, regardless of whether it has ever been used in any way in connection with popcorn (emphasis added)." Such reasoning obviously applies to rejections under 35 U.S.C. § 103. Schrieber confirms the guidance provided in Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Int. 1987), that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus for a prior art apparatus satisfying the claimed structural limitations. Note also Ex parte Wikdahl, 10 USPQ2d 1546, 1548 (Bd. Pat. App. & Int. 1989) and In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967).

Even though we recognize that Endo does not specifically teach an application to wells or well tools, it is

well settled that the manner in which a claimed apparatus such as in claim 44 is intended to be employed does not differentiate the claimed apparatus from prior art apparatuses satisfying the claimed structural limitations. Appellant's remarks at pages 12 and 13 of the Brief do not address this reasoning and no reply brief has been filed.

As to the rejection of dependent claim 45, it recites that the control modules include a WDM drop connected between the fiber optic line and the respective well tool.

As to this rejection, we do not agree with the examiner's correlation that the directional couplers 11 in figure 4 of Endo relate to the features recited of a WDM drop as noted at page 8 of the Answer. On the other hand, at page 14 of the Answer, the examiner takes the position that such a drop is the light divider 12 in figure 4, merely alleging that it can function as such a drop. Inasmuch as there is no specific teaching of such a drop in the reference, we are persuaded by appellant's arguments at pages 13 and 14 of the Brief that such drops were well understood by those in the art and specifically discussed as to its functionality at Specification, page 6, lines 22 through 28. The optical filter arrangement 12 in

figure 4 of Endo does not permit the passing through of all other wavelengths even though it effectively "drops" a specific wavelength. We understand that an optical filter does not correspond to the claimed WDM drop in claim 45. Therefore, we reverse the rejection of this claim.

As to claim 47, we agree with the examiner's brief observations at page 8 of the Answer correlating the subject matter of this claim to Endo's teachings in figure 4 which appears to read directly on the subject matter of the claim. According to our earlier analysis, at least a selected one of a plurality of wave bands is capable of being passed by the optical filter as claimed. As to appellant's arguments at page 15 of the Brief, we do not agree with the view expressed that Endo describes only the use of a single divider 12 connected at the end point of the optical fiber 40 since a plurality of optical filters 12-1 through 12-3 are illustrated.

We also sustain the rejection of dependent claim 48 since it essentially mirrors the argued subject matter of independent claim 25 discussed earlier in this opinion. We also sustain the rejection of dependent claims 49, 54 and 55 since appellant's grouping at page 5 of the Brief indicates that these

claims are grouped with claim 44 and no arguments are presented in the substance of the Brief anyway.

When we turn to the subject matter of dependent claim 52, we sustain the rejection of this claim because of our earlier analysis with respect to claim 30 where we indicated that the artisan would well appreciate that multiple lasers may be usable for each of the respective optical switches 20-1 through 20-3 in figure 4 to embody the generalized teachings of the light emitting element 22 in figure 2. Correspondingly, however, we must reverse the rejection of dependent claim 53 because there is no teaching or suggestion in Endo that the multiple lasers of claim 52 or any one of them may be tunable. Our reason for reversing claim 53 therefore is basically the same reasoning as we advanced earlier with respect to our reversal of claim 30.

We now turn to the features of dependent claim 56. We find ourselves in agreement with the examiner's reasoning at page 9 of the Answer that the corresponding teachings relied upon by the examiner at columns 3 and 5 of Endo teach broadly the feature of data being transmitted in a selected one of digital and analog formats. Appellant's arguments at page 18 of the Brief appear to admit that Endo describes the system of merely

turning devices in an automobile on or off, which does not contest the examiner's reasoning of unpatentability. It appears to us that the artisan would clearly interpret Endo's circuit to operate either on analog or digital data or both.

Lastly, we also reverse the rejection of dependent claims 57 and 58 for the same reasons we reverse the rejection of independent claims 39 and 40 earlier.

Next, we turn to the stated rejection under 35 U.S.C. § 103 of claim 19 as being obvious over Pitt in view of Davis. Since we sustain the rejection of claim 19 in light of the examiner's initial statement of the rejection at pages 4 and 5 of the Answer, in addition to the remarks at pages 14 and 15 of the Answer responding to appellant's arguments in the Brief, we add the following for emphasis. Claim 18 recites the feature at the end of the claim of a power consuming device being a data storage device where data is transmitted through the fiber optic device where it is stored in the data storage device.

The background of the invention of Pitt's patent at column 1 indicates that it was known in the art that a controllable device included bimetallic strips or memory metal strips which are otherwise disclosed as a part of the ability to detect

the signals at column 4 and which would clearly include the memory elements or storage devices claimed. Even though such elements would not necessarily be changeable such that data transmitted through a fiber optic length may be stored in them, since the artisan would appreciate that such memory metals would already have data fixedly stored in them per se, we find it would have been obvious to the artisan to have employed data storage devices of the nature taught in Davis as argued by the examiner to add the additional feature that data may be individually storable or selectively storable in the devices as well. Even though the showings in the three embodiments in figures 6 through 8 of Pitt indicate that at least individually, utilization-type devices may be individually controllable with respect to each remote power consuming station, the selectability is well known in the art according to the discussion in the background of the invention at column 1 of Pitt. The examiner is correct in making reference to the additional teachings at column 1, lines 52 through 55, as a plurality of type of remote devices.

According to the examiner's reasoning, it appears to us that the generic type of utilization devices in figures 6

through 8 of Pitt obviously would have been specialized as memory devices according to the teachings in Davis. Coupled with the earlier-noted teachings of memory metal devices noted earlier in this opinion, it appears to us that the artisan would have found a requisite motivation to have combined the teachings of the references contrary to the arguments at page 21 of the Brief. Because Pitt already teaches memory type devices that are not apparently changeable by data being transmitted thereo, the obvious enhancement of the type of traditional data storage devices in Davis leads us to conclude that there is no valid hindsight argument that can be made as set forth at the bottom of page 21 of the Brief. A teaching at column 5, lines 55 through 61, of Davis does contemplate that other types of communication channels or paths may exist between the portable length 20 and the data storage devices 22 shown in figure 1, such as to broadly encompass the fiber optic approaches or optical approaches taught by Pitt. Therefore, we sustain the rejection of independent claim 19 under 35 U.S.C. § 103.

Finally, we also sustain the rejection of independent claim 20 for the reasons set forth by the examiner in the Answer. The argued feature here is the last clause of claim 20 where it

recites power consuming devices may have programmed functions that are performed in response to receiving the power from the fiber optic cable.

According to the teachings at column 1, lines 52 through 55, relied upon by the examiner, Pitt contemplates that his system may be utilized for supplying power remotely to surveillance, communications and control systems or devices. It appears to us that the artisan would well appreciate the corresponding teachings of Tymes emphasizing the optical transmission of modulated information from a light source 110 to individualized display devices 102 through 108 as in figure 1 of this reference. Tymes is an exemplary form of the broadly defined communications and control devices noted at the bottom of column 1 of Pitt. Thus, we agree with the examiner's basic rationale that it would have been obvious to have combined the teachings of Tymes into the overall system of Pitt contrary to appellant's generalized contrary urging at the bottom of page 22 of the Brief.

The showing in figure 4 of Tymes and the discussion of this figure at the bottom of column 3 of this reference indicates specifically that individualized device identification commands

are transmitted in any data packet 180 that may be sent from the light source 110 to the separate display devices 102 through 108. Thus, it is clear to us that the individual display devices may be selected according to the specific commands issued. We therefore do not agree with appellant's urging to the contrary at page 22 of the Brief.

As an additional passing comment, from our study of the combination of teachings of Pitt and Tymes, the embodiments in figures 1, 5 and 6 of Tymes also would have indicated the obviousness of the subject matter of independent claim 19, which we recognize has not been rejected on this combination of references. Each of the microprocessors 132 in these figures has within it an addressable RAM 192 which is clearly a data storage device to which data has been optically transferred for storage as discussed in the paragraph at column 4, lines 47 through 59, of Tymes.

In summary, among the rejections of the claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103, we have sustained the respective rejections of claims 19, 20, 25, 44, 47 through 49, 52 and 54 through 56. On the other hand, we have reversed the respective rejections of claims 30, 39, 40, 45, 53, 57 and 58. Therefore, the decision of the examiner rejecting various claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS
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